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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09/807,165	07/02/2001	Peter Daute	H3722PCT US	3060

23657 7540 02/28/2003

COGNIS CORPORATION
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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 02/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807.165

Applicant(s)

DAUTE ET AL

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 6-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites that the granules are "substantially" spherical. The scope of the claim is confusing because it is not clear what is meant by "substantially". When is the granule considered "substantially" spherical? Clarification is requested.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 6-12, 15-19, and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Carduck et al. (U.S. 5,318,733).

Carduck et al. disclose composition comprising granules containing lubricant wherein the granules have diameter of 0.5-5 mm, preferably 0.8-3 mm, and length to diameter ratio of 1:1 to 3:1. The granules are made by extruding, using a twin-screw extruder, composition comprising granules into a fine strand, cutting the fine strand into cylindrical granules, and then spheronizing or rounding the cylindrical granules to form spherical granules. The composition is extruded at a temperature of 60-70 °C and pressure of 25-200 bar. The spheronizing is accomplished using spheronizer having rotating bottom disk using a residence time of 5-120 seconds. It is further disclosed that the granules are treated with active substances either during or after spheronizing (col.2, line 67-col.3, line 9, col.3, lines 47-50, col.5, lines 61-63, col.6, lines 1-2, 8-9, 15-27, and 34-45, col.7, lines 3-7 and 16-24, col.7, line 59-col.8, line 8, col.14, lines 16-35, and col.16, lines 54-57).

In light of the above, it is clear that Carduck et al. anticipate the present claims.

5. Claims 6-14 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Thibaut et al. (U.S. 5,597,857).

Thibaut et al. discloses plastic composition comprising granules containing plastic additive such as calcium stearate wherein the granules have a diameter of 2-6 mm. The granules are spherical with a regular shape and size and are made using a twin-screw extruder. There is also disclosed a method of stabilizing plastics comprising combining providing plastic composition with granular composition (col.1, lines 61-64, col.2, lines 1-6 and 31-33, col.3, lines

5-8 and 15-19, col.32, lines 36-38, col.34, lines 57-60, col.38, lines 28-32, and example 1). From example 1, it is calculated that the granules have length to diameter ratio of 1:1 (2 2) to 3:1 (6 2).

With respect to claims 15-20, it is noted that there is no disclosure in Thibaut et al. of how the granular composition is made. That is, while Thibaut et al. disclose spherical or rounded granules, there is no disclosure that these spherical granules are made by providing cylindrical granules which were produced in a twin screw extruder at certain temperature and pressure conditions followed by spheronizing the cylindrical granules using spheronizer with certain rotational speed and residence time. However, it is noted that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself". See MPEP 2113.

Thus, although Thibaut et al. does not disclose the specific presently claimed process conditions, it is noted that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process". *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, "although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product", *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).

Therefore, absent evidence of criticality regarding the presently claimed process to make the granular composition and given that Thibaut et al. meets the requirements of the claimed

granular composition, i.e. composition comprising spherical granules. Thibaut et al. clearly meet the requirements of present claims 15-20.

In light of the above, it is clear that Thibaut et al. anticipate the present claims.

6. Claims 6-11, 15, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Balliello et al. (U.S. 6,423,132).

Balliello et al. disclose pigment granules which have length to diameter ratio of 1-10 :1-3. The granules are made by extruding, using a twin-screw extruder, composition comprising granules into a fine strand, cutting the fine strand into cylindrical granules, and then spheronizing or rounding the cylindrical granules to form spherical granules. The spheronizing is accomplished using spheronizer having rotating bottom disk (col.4, lines 36-37 and 53-62, col.5, lines 5-7, col.14, lines 47-54, and col.15, lines 43-49).

In light of the above, it is clear that Balliello et al. anticipate the present claims.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carduck et al. (U.S. 5,318,733) in view of Reynolds (U.S. 3,741,703).

The disclosure with respect to Carduck et al. in paragraph 4 above is incorporated here by reference.

The difference between Carduck et al. and the present claimed invention is the requirement in the claims of the rotational speed at which spheronizing is performed.

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Carduck et al. disclose spheronizing cylindrical granules using spheronizer with rotating bottom disk with residence time of 15-120 seconds, however, there is no disclosure of the rotational speed at which spheronizing is performed.

Reynolds, which is drawn to apparatus for making spherical granules, discloses using spheronizer with rotating bottom disk at rotating speed of 30-1500 rpm wherein the speed utilized controls the uniformity of size of the spheres produced (col.1, lines 1-7, col.4, lines 16-40, and col.5, lines 14-20).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use spheronizer with rotating speed, including that presently claimed, in order to produce spherical granules with uniform size, and thereby arrive at the claimed invention.

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Balliello et al. (U.S. 6,423,132) in view of Reynolds (U.S. 3,741,703).

The disclosure with respect to Balliello et al. in paragraph 6 above is incorporated here by reference.

The difference between Balliello et al. and the present claimed invention is the requirement in the claim of the rotating speed and residence time associated with the spheronizer.

Balliello et al. disclose forming spherical granules using spheronizer with rotating bottom disk, however, there is no disclosure of the rotating speed and residence time associated with the rotating disk.

Reynolds, which is drawn to apparatus for making spherical granules, discloses using spheronizer with rotating bottom disk at rotating speed of 30-1500 rpm and residence time of 15 second to 5 minutes wherein the speed and residence time utilized controls the uniformity of size of the spheres produced (col.1, lines 1-7, col.4, lines 16-40, and col.5, lines 14-20).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use spheronizer with rotating speed and residence time, including that presently claimed, in order to produce spherical granules with uniform size, and thereby arrive at the claimed invention.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

EP 802241 discloses granules comprising pigment, however, there is no disclosure of the length to diameter ratio of the granules.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

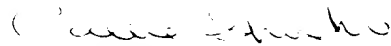
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho
Examiner
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